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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,760

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Gregor John McLennan Anderson

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07/26/2004

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EXAMINER

MULLEN, THOMAS J

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,760

Applicant(s)

ANDERSON ET AL.

Examiner

Thomas J. Mullen, Jr.

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2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004 and 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-29 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-29 and 33-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 April 2004 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The amendment filed 4/9/04 has been entered, and fully considered. (The response filed 6/10/04 was helpful in determining the proper insertion points for various changes presented in the 4/9/04 amendment; applicant should note that the 6/10/04 response itself was not entered.)
2. The proposed drawing changes set forth in the five drawing sheets submitted 4/9/04 are approved; however, these drawing sheets are informal and are not labeled "Replacement Sheet", so the original drawing sheets remain in the case. Formal drawings incorporating the approved changes are required.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 3-29 and 33-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 as amended, it is unclear if there is any intended difference in meaning between "received by said housing" (line 4) and "provided to the housing" (line 7), as to the physical relationships between the housing and the "medicament container" (line 4) and between the housing and the "electronic data management system" (line 7), respectively.

In claim 1, it is unclear whether the "data" and/or the "electronic data management system" (recited on the last 9 lines of the claim) have anything to do with the dispensing of a "medicament" (recited on the first 6 lines of the claim); note that there is nothing in claim 1 which associates the "data" (or the electronic components of the device, which handle the data) with any aspect of the operation of the medicament dispenser. Thus, the nature of the "data" in claim 1 cannot be determined (see paragraph 7 in the last Office action).

5. Claims 1, 4, 5, 10, 12, 27, 33, 35, 39-40 and 47-48 are rejected under 35 U.S.C. 102(e) as being anticipated by McKinnon et al (US 6,202,642).

Note in McKinnon et al, housing 100 (Figs. 1, 2, 5, etc.); medicament container 500 received by the housing; dispensing mechanism (104,524,etc.) associated with the medicament

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container; "electronic data management system" 116 provided to the housing (see e.g. Fig. 4 and col. 9, lines 24-40), and including memory 432, microprocessor 428 and a "transmitter" (e.g., bi-directional transmit/receive line between elements 428 and 400, as generally depicted in Fig. 4); communicator 400 ("IR port" in Fig. 4--see col. 4, lines 1-4) associated with the electronic data management system; and "remote network"-computer system (i.e. computers connected over a POTS network or over the Internet--note e.g. elements 304,308,312 in Fig. 3, and col. 4, lines 4-17). It is inherent that at least a portion of the "network computer system", with which portable device 100 is in communication (e.g. element 308 in Fig. 3), is "remote" from the portable device 100 (note also that a "network" implicitly includes a plurality of communication stations which are "remote" from each other). McKinnon et al teaches that communication from the electronic data management system 116 to the network (304,308,312) may be (at least partly) "wireless", note "wireless data communications" infrared transceiver 400 of the EDMS 116 and infrared transceiver 404 of a docking station 300, which in turn communicates with the network (col. 3, line 46 to col. 4, line 4). The communication between the "network computer system" and the "electronic data management system" in McKinnon et al involves "two-way transfer of data", as claimed (see e.g. col. 4, lines 10-13).

Regarding claim 4, McKinnon et al teaches that the "wireless" transmission to/from the "communicator" may be in the form of at least one of "radiofrequency" or "optical" signals.

Regarding claim 5, where McKinnon et al teaches that the network associated with the "remote network"-computer system may be the Internet as discussed above, and the Internet is known to comprise "gateways" for providing access thereto, it is inherent that communication between the "communicator" and a network computer occurs via a "gateway" associated with the Internet.

Regarding claim 10, the Internet (which may form the basis for the remote network computer system in McKinnon et al, as discussed above) is generally known to be a "public access" network.

Regarding claim 12, where McKinnon et al teaches that the network associated with the remote network computer system may be the Internet as discussed above, and where each user (or access point) of the Internet by necessity has an "address" associated therewith, it is inherent

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that each access point in the "network computer system" of McKinnon et al (e.g. workstation 308 in Fig. 3) has a "user-specific network address".

Regarding claim 27, note display 440 in McKinnon et al.

Regarding claims 33 and 35, note "detector(s)" 416 and 420 in McKinnon et al (col. 9, lines 41-59), which implicitly communicate dispensing occurrences and breathing occurrences, respectively, as "data" to controller 428.

Regarding claims 39-40, the "breath" sensor 420 of McKinnon et al is described as an "air flow" sensor (col. 9, line 54) and is also described as a thermistor (col. 9, line 56), which is a form of "temperature" sensor.

Regarding claims 47-48, McKinnon et al teaches using the portable device with either "aerosol" containers or "dry powder" containers (col. 15, lines 47-51), and canister 500 (at least when used as an aerosol container) has a "dispensing valve" (col. 9, lines 44-45).

6. Claims 3, 6-9, 11, 13-26, 28-29, 34, 36-38, 41-46 and 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed 4/9/04 have been fully considered but they are not persuasive, as to the rejections maintained (or newly set forth) above.

Regarding the issue under 112(2) as to the association between "data" and the dispensing of "medicament", applicant argues that the nature of the "data" is "established throughout the specification" and "would be understood by one of ordinary skill". However, it is maintained (see the more detailed explanation in paragraph 4 above) that claim 1 fails to associate in any manner the "data" with the "dispensing", such that one of ordinary skill would not understand (from claim 1 as written) what the "data" pertains to.

Regarding McKinnon et al, applicant merely draws an analogy of that reference with the Wolf reference (which is not applied to the claims in this action), and states that transfer of data via a docking station "contrast(s) with the instant invention which allows data to be transmitted 'on the move' via its wireless connection"; however, McKinnon et al differs significantly from Wolf (at least in specifying that communication occurs over a "remote network computer

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system" such as the Internet), and it is considered that the "contrast" alleged by applicant is not adequately set forth in the language of claim 1, for reasons given in paragraph 5 above. The statement in the preceding paragraph, that McKinnon "for these same reasons" fails to anticipate certain claims, is not understood since it is unclear what "reasons" are contemplated by this statement.

Applicant's remaining comments, regarding various other rejections and objections of the application, are considered persuasive.


8. This Office action is non-final.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 703-305-4382. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (703) 308-6730. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9313.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TJM


Thomas J. Mullen, Jr.
Primary Examiner
Art Unit 2632